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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/595,677	06/19/2000	Raviv Laor	56354-018 (LAOL-116/PT)	3948

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EXAMINER

GRAVINI, STEPHEN MICHAEL

ART UNIT PAPER NUMBER

3622

DATE MAILED: 02/12/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/595,677

Applicant(s)
Raviv LAOR

Examiner
Stephen M. Gravini

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12-24-02
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 4, 7, 8 6) ☐ Other:

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DETAILED ACTION

Requirements for Information

1. 37 CFR 1.105 states: (a) (1) In the course of examining or treating a matter in a pending or abandoned application filed under 35 U.S.C. 111 or 371 (including a reissue application), in a patent, or in a reexamination proceeding, the examiner or other Office employee may require the submission, from individuals identified under § 1.56(c), or any assignee, of such information as may be reasonably necessary to properly examine or treat the matter, for example:

- (I) Commercial databases : The existence of any particularly relevant commercial database known to any of the inventors that could be searched for a particular aspect of the invention.
- (ii) Search : Whether a search of the prior art was made, and if so, what was searched.
- (iii) Related information : A copy of any non-patent literature, published application, or patent (U.S. or foreign), by any of the inventors, that relates to the claimed invention.
- (iv) Information used to draft application : A copy of any non-patent literature, published application, or patent (U.S. or foreign) that was used to draft the application.

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(v) Information used in invention process : A copy of any non-patent literature, published application, or patent (U.S. or foreign) that was used in the invention process, such as by designing around or providing a solution to accomplish an invention result.

(vi) Improvements : Where the claimed invention is an improvement, identification of what is being improved.

(vii) In Use : Identification of any use of the claimed invention known to any of the inventors at the time the application was filed notwithstanding the date of the use.

(2) Where an assignee has asserted its right to prosecute pursuant to § 3.71(a) of this chapter, matters such as paragraphs (a)(1)(I), (iii), and (vii) of this section may also be applied to such assignee.

(3) Any reply that states that the information required to be submitted is unknown and/or is not readily available to the party or parties from which it was requested will be accepted as a complete reply.

(b) The requirement for information of paragraph (a)(1) of this section may be included in an Office action, or sent separately.

(c) A reply, or a failure to reply, to a requirement for information under this section will be governed by §§ 1.135 and 1.136.

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2. The Office is requiring submission of information reasonably necessary to properly examine and treat the claimed subject matter under Rule 105. Of particular interest is information used in drafting the present operation, business practices used by applicant's professional business ventures, to show the information used in the invention process, and identification of any use of the claimed invention known to the inventor at the time the application was filed notwithstanding the date of the use.

Information Disclosure Statement

3. Examiner objects to the tremendous volume of references because more than 170 references, totaling more than 10,000 pages, were submitted. In order for the examiner to properly determine patentability over the prior art submitted, it is requested that the patent owner explain the significance of each reference or highlight those documents which have been specifically brought to patent owner's attention and/or are known to be of most significance. It is desirable to avoid the submission of long lists of documents. Examiner requests elimination of clearly irrelevant and marginally pertinent cumulative information. See *Penn Yan Boats, Inc. v. Sea Lark Boats, Inc.*, 359 F. Supp. 948, 175 USPQ 260 (S.D. Fla. 1972), *aff'd*, 479 F.2d 1338, 178 USPQ 577 (5th Cir. 1973), cert. denied, 414 U.S. 874 (1974). But cf. *Molins PLC v. Textron Inc.*, 48 F.3d 1172, 33 USPQ2d 1823 (Fed. Cir. 1995).

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Claim Rejections - 35 USC § 101

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. Claims 12-20 are rejected under 35 U.S.C. 101 because the claimed method does not recite a useful, concrete and tangible result under *In re Alappat*, 31 USPQ2d 1545 (Fed. Cir. 1994) and *State Street Bank & Trust Co. v. Signature Financial Group Inc.*, 47 USPQ2d 1596 (Fed Cir. 1998). The independently claimed invention is an abstract idea which can be performed without interaction of a physical structure. The independently claimed steps of establishing and transferring data do not require structural interaction or mechanical intervention such that the invention falls within the technological arts permitting statutory protection. The establishing and transferring data steps can be performed by thinking and speaking such that the claimed steps can be performed without a physical structure or mechanical object. Because the independently claimed invention is directed to an abstract idea and does not require structural interaction or mechanical intervention, it does not produce a useful, concrete and tangible result, is not permitted under 35 USC 101 as being related to non-statutory subject matter. Furthermore each of the claimed steps can be completely performed by a human which further illustrates that the independently claimed invention is directed to an abstract idea and does not require structural interaction or mechanical intervention. The dependently claimed invention is also rejected since those claims are dependent upon what is considered non-statutorily permitted subject matter.

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However in order to examine the claimed invention in light of the prior art, further rejections will be made on the assumption that those claims are statutorily permitted.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

7. Claims 1-27 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. In this case, the independently claimed method and system including the steps of establishing and transferring data (including means steps thereof) are not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The independently claimed steps of specifically reciting features of data representative of one or more terms and statistics of one or more item promotions and of being selectively coupleable including a promotion code with data representative of the terms and statistics of promotions are considered non-enabling because the specification does not provide a concrete example or illustrating of those claimed steps. The specification discusses these claimed concepts but does not enable one skilled in the art how the

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data representative of one or more terms and statistics of one or more item promotions is enabled or how being selectively coupleable including a promotion code with data representative of the terms and statistics of promotions is enabled, such that one would know how to make and/or use the invention. However in order to examine the claimed invention in light of the prior art, further rejections will be made on the assumption that those claims are reasonably conveyed to those skilled in the art.

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. Claims 1-27 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The independently claimed method and system including the steps of establishing and transferring data (including means steps thereof) fails to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The independently claimed steps of specifically reciting features of data representative of one or more terms and statistics of one or more item promotions and of being selectively coupleable including a promotion code with data representative of the terms and statistics of promotions are considered indefinite because the specification does not provide an antecedent basis of those claimed steps. The specification discusses these claimed concepts but does not particularly point out and distinctly

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claim the subject matter which applicant regards as the invention because it is considered that how the data representative of one or more terms and statistics of one or more item promotions is indefinite or it is considered that how being selectively coupleable including a promotion code with data representative of the terms and statistics of promotions is also indefinite. The claims also contain terms which lack a proper antecedent basis. Some of the terms include “the number,” “the value,” “the redeemed,” (claims 3, 9, and 10), “the internet,” (claims 4, 13, and 27), “the promotion data,” (claim 5), “the total number” and “the total value,” (claims 9 and 10), “the step,” (claims 17 and 18), “the dollar value,” (claim 19), “the promotions redeemed,” (claims 19 and 20), and “the identity,” (claims 21 and 22). However in order to examine the claimed invention in light of the prior art, further rejections will be made on the assumption that those claims are not indefinite.

Claim Rejections - 35 USC § 102

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

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The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

11. Claims 1-27 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Nichtberger et al. (US 4,882,675), Humble (US 4,949,256), von Kohorn (US 5,128,752), Off et al. (US 5,173,851), Ferguson et al. (US 5,256,863), Filepp et al. (US 5,347,632), de Lapa et al. (US 5,353,218), Weinblatt (US 5,401,946), Carles (US 5,515,098), Deaton et al. (US 5,644,723), Christensen et al. (US 5,710,886), Bezos (US 5,715,399), Reilley et al. (US 5,740,549), Herz et al. (US 5,754,939), Golden et al. (US 5,761,648), Walker et al. (US 5,794,207), O'Brien et al. (US 5,832,457), Gerace (US 5,848,396), Jovicic et al. (US 5,855,007), Harrison (US 5,878,222), Fajkowski (US 5,905,246), or Gregory (US 5,909,673), and are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Angles (US 5,933, 811), Merrimen et al. (US 5,948,061), Krishnamurthy (US 5,956,027), Scroggie (US 5,970,469), Guiliani et al. (US 5,974,399), Jermyn (6,026,370), Eggleston et al. (US 6,061,660), Hoyle (US 6,141,010), or Simons et al. (US 6,230,143).

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12. Claims 1-27 are rejected under 35 U.S.C. 102(b) based upon a public use or sale of the invention. An inventor name and assignee search within the USPTO intranet PALM system shows that each element claimed has been assigned to an assignee more than one year prior to the filing of the present application. An examination of the application file shows that the inventor is claiming small entity status but has assigned an application that has matured into a patent to a large entity corporation more than one year prior to filing of the present application. The patent issuing from the assigned patent contains all the elements of the presently claimed invention. It is considered public use to assign the claimed elements to another more than one year prior to filing and considered to be a proper rejection under the anticipatory statute.

13. An issue of public use or on sale activity has been raised in this application. In order for the examiner to properly consider patentability of the claimed invention under 35 U.S.C. 102(b), additional information regarding this issue is required as follows: when each of the claimed elements was placed in public use or offered for sale more than one year prior to filing of the present application. Applicant is reminded that failure to fully reply to this requirement for information will result in a holding of abandonment.

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Claim Rejections - 35 USC § 103

14. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

15. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

16. Claims 1-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over an obvious variation of examiner's personal experience of a method and system for telephone transactions from a Performance Bike Company (hereinafter Performance) sales catalog. Since at least 1994, examiner has experienced the method and system of Performance offering promotions associated with a store and commercially coupleable sales via a telephone such that each sales catalog contains a promotion code for shopper discounts. The claimed recitation including an authorization code, valuation and statistics of redeemed promotions, data display, and enablement. The claimed invention has been performed except for the recited servers, computer

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processors, and internet which are considered automated features of what is old and well known. Examiner takes Official notice that it is old and well known to those skilled in the art of a method and system for managing promotions over a network, that it would have been obvious to claim the invention as recited by the applicant, in order to overcome the expressed teachings of the examiner's experience. Furthermore examiner experience teaches the claimed invention except for the claimed automated features, such that the claimed invention is considered merely an automated feature of a concept that is old and well known as discussed above. Please see *In re Venner*, 262 F.2d 91, 95, 120 USPQ 193, 194 (CCPA 1958) in which the court held that broadly providing an automatic or mechanical means to replace a manual activity which accomplished the same result is not sufficient to distinguish over the prior art. The motivation to combine applicants claimed invention with the services offered by Performance is to allow advertisers greater consumer targeting capabilities through electronic mediums, while transferring electronic information, which clearly shows the obviousness of the claimed invention.

Double Patenting

17. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed.

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Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

18. Claims 1-27 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-28 of U.S. Patent No. 6,041,309 or over claims 1-14 of U.S. Patent No. 6,076,069. Although the conflicting claims are not identical, they are not patentably distinct from each other because the patented term “electronic coupon” is an obvious variation over the presently recited “promotion.”

19. Claims 1-27 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-31 of copending Application No. 09/573,279 or over claims 1-34 of copending Application No. 09/573,706 or

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over claims 1-72 of copending Application No. 09/573,727 or over claims 1-26 of copending Application No. 09/596,664. Although the conflicting claims are not identical, they are not patentably distinct from each other because they are not patentably distinct from each other because the patented term “electronic coupon” or “electronic coupon cookie” or “e-tail server” or “promotion code” are obvious variations over the presently recited “promotion.”.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Conclusion

20. Any inquiry concerning this communication or earlier communication from the examiner should be directed to Steve Gravini whose telephone number is (703) 308-7570 and electronic transmission / e-mail address is “steve.gravini@uspto.gov”. Examiner can normally be contacted Monday through Friday from 6:00 a.m. to 3:30 p.m. **If applicant chooses to send information by e-mail, please be aware that confidentiality of the electronically transmitted message cannot be assured.** Please see MPEP 502.02. Information may be sent to the Office by facsimile transmission. The Official Fax Numbers for TC-3600 are:

After-final	(703) 872-9327
Official	(703) 872-9326
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STEPHEN GRAVINI
PRIMARY EXAMINER

smg
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